As previously submitted, it is well settled law that in order for the prior art of record to be anticipatory under 35 U.S.C. § 102, the prior art must disclose each and every **feature** of the claimed invention. Here, such a standard has not been met.

Claims 1, 33, 34, 49, 50 and claims depending therefrom recite a composition comprising at least: (1) a minimum amount of ethanol; and (2) a minimum amount of methyl acetate and/or t-butyl acetate. Likewise, Claim 43 and claims depending therefrom similarly recite a composition comprising at least: (1) a minimum amount of isopropanol; and (2) a minimum amount of methyl acetate and/or t-butyl acetate. Therefore, it necessarily follows that at least one **feature** of the presently claimed invention is a **combination** of: (1) ethanol and methyl acetate and/or t-butyl acetate, or (2) isopropanol and methyl acetate and/or t-butyl acetate.

In establishing the alleged anticipatory rejection, the Office Action relies on nothing more than a broad disclosure of possible compounds that can be mixed and matched to provide hundreds of possible combinations. Accordingly, the Examiner's attention is drawn to the well established principle that a broad generic disclosure of all potential combinations, without more, is not *per se* sufficient to anticipate a specifically claimed combination unless that specific combination can be "at once envisaged" by one of ordinary skill in the art. See MPEP § 2131.02. For example, in In re Ruschig, the court found a generic disclosure, which encompassed 130 possible chemical compounds, sufficiently broad so that it no longer provided a small class of compounds with common recognizable properties 343 F.2d 965, 145 U.S.P.Q. 274 (CCPA 1965) (a copy of the cited decision is attached herewith as Exhibit "A"). As such, the disputed claim, which was directed to a particular species falling within the broad disclosure of 130 possible compounds, was **not** anticipated for purposes of 35 U.S.C. § 102(b). Id. In other words, the claimed species could not be "at once envisaged" by one of ordinary skill in the art in view of the art of record.

With regard to the present facts, both Madrange and Heeb similarly disclose broad generic lists of possible chemical compounds and combinations but nonetheless fail to specifically disclose the claimed combinations of the instant invention. Specifically, Madrange discloses a hair care composition containing **at least one of**: (a) a lower alkanol, such as ethanol, propanol, isopropanol or butanol; (b) a solvent such as 1,1,1-trichloroethane and methylene chloride; and (c) a diluent such as a ketone, in particular acetone and methylethyl ketone; an alkyl acetate, in particular methyl acetate or ethyl acetate, or a hydrocarbon, in particular a C_3-C_7

alkane. Furthermore, Madrange also makes clear that none of components (a), (b) or (c) is required. As such, Madrange discloses a "laundry list" of **at least 149** possible chemical combinations.[1] Likewise, Heeb discloses a pressurized aerosol formulation comprising at least one of 23 possible solvents that can be used alone or in combination. Considering one solvent alone and only those possible combinations of any two listed solvents, Heeb similarly discloses a "laundry list" of **at least 276** possible combinations.[2]

In view of the legal precedent set by the seminal case of In re Ruschig, neither Madrange nor Heeb teach or even suggest a composition comprising the claimed combinations set forth above. As such, neither reference discloses each and every **feature** of the present invention and therefore fails to meet the anticipatory standard enumerated above. Applicants therefore respectfully request that these rejections be withdrawn.

II. Obviousness Rejections Under 35 U.S.C. § 103(a)

The Office Action has also reiterated the previous rejection of claims 1-48 under 35 U.S.C. § 103(a) as allegedly being obvious in view Madrange or, alternatively, in view of Heeb. Once again, while Applicants respectfully submit that these rejections are in error, the following Remarks are believed to obviate the Examiner's concerns in this regard.

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[1] The number 149 was calculated as follows:

Component (a) discloses **4** preferable species; component (b) discloses **2** preferable species; and component (c) discloses **9** preferable species. Accordingly, there are:

1) 4 times 2, or 8 combinations of only component (a) and (b).
2) 4 times 9, or 36 combinations of only components (a) and (c).
3) 2 times 9, or 18 combinations of only components (b) and (c).
4) 4 times 2 times 9, or 72 combinations of components (a), (b) and (c).
5) 4 plus 2 plus 9, or 15 possibilites of only one of components (a), (b) and (c)

Therefore, the sum of 8, 36, 18, 72, and 15 is 149.

[2] The number 276 was calculated using the following formula:

$$n!/[(n-r)!r!]$$

wherein "n" is the total number of elements (in this case 23 species) and "r" is the number of elements in the subset (in this case a combination of any 2 species). Therefore,

$$23!/[(23-2)!2!] = 253$$

However, there are also 23 possibilities if only one of the 23 species is used. Therefore, 253 + 23 = 276.

In order to show a *prima facie* case of obviousness, the art of record must teach, or at least suggest, the claimed invention as a whole. Moreover, there must also be adequate motivation and a reasonable expectation of success to undertake the modification proposed in the rejection. Here, neither standard has been met.

As previously set forth in detail, Claims 1, 33, 34, 49, 50 and claims depending therefrom recite a composition comprising at least: (1) a minimum amount of ethanol; and (2) a minimum amount of methyl acetate and/or t-butyl acetate. Likewise, Claim 43 and claims depending therefrom similarly recite a composition comprising at least: (1) a minimum amount of isopropanol; and (2) a minimum amount of methyl acetate and/or t-butyl acetate.

Madrange and Heeb are not only silent with respect specific compositions comprising these claimed combinations, but rather only disclose a laundry list of hundreds of suitable compounds and possible combinations. As such, other than the provided examples, there is no indication in either Madrange or Heeb of which of the hundreds of possible chemical combinations should be chosen. Moreover, none of the examples teach or even suggest a composition comprising the claimed combinations of the instant invention. Therefore, one of ordinary skill in the art would not have been motivated by these disclosures, alone or in combination, to arrive at the combination of features recited in the present claims. Accordingly, it is respectfully submitted that neither Madrange nor Heeb render claims 1-50 prima facie obvious and, as such, these rejections should be withdrawn.

Additionally, the presently claimed invention achieves the advantages of: (i) reducing the consmetically unacceptable odor associated with alkyl acetates such as methyl acetate and t-butyl acetate; (ii) inhibiting the hydrolysis of methyl acetate and/or t-butyl acetate in the presence of water to thereby reduce the formation of harmful acids; and (iii) reducing the volatile organic compound content of the hair care compositions to governmentally acceptable levels. These advantages are not taught nor suggested in the prior art, and there is no motivation in the art to achieve such advantages. Therefore, even assuming arguendo that a prima facie case of obviousness were set forth (which it is not), the present invention achieves unexpected and superior results not shown in the art, which therefore rebutts any prima facie case of obviousness. For this separate and/or additional reason, the claimed invention is non-obvious, and so, the §103 rejection should be withdrawn.

CONCLUSION

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned **"Version With Markings to Show Changes Made."**

In view of the remarks set out above, it is respectfully asserted that the rejections in the May 9, 2001 Office Action have been overcome and that the application is in condition for allowance. Therefore, Applicants respectfully seek notification of the same.

Enclosed herewith is a check in the amount of $920.00 (check no.489474) for the three-month extension of time. No additional fee is believed due; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail Invoice No. EL924048577US in an envelope addressed to: Box RCE, Assistant Commissioner for Patents, Washington, D.C. 20231, on the date indicated below.

Erick J. Calderon — 11/5/01
Erick J. Calderon — Date

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

New claims 49 and 50 have been added as follows:

-- 49. A hair care composition comprising:

a. a fixative;

b. ethanol; and

c. methyl acetate and/or t-butyl acetate;

wherein the volatile organic compound content of the composition is not higher than 80%.

50. A hair care composition comprising:

a. a fixative;

b. ethanol; and

c. methyl acetate and/or t-butyl acetate;

wherein the amount of component (b) is sufficient to substantially inhibit the hydrolysis of component (c) when water is present. --